

REMARKS/ARGUMENTS**I. Summary**

Claims 1-46 are pending in the application. In the non-final Office Action mailed January 13, 2005 ("Office Action"), claims 1-46 were rejected. Claim 38 has been amended to correct a typographic error. The issues in the Office Action are:

- Claims 1-5, 7, 11-13, 18-23, 25-27, 29-35, 37-42, and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated over *Adamske et al.* (U.S. Patent No. 6,615,234, hereinafter *Adamske*).
- Claims 6, 8, 14-16, 24, 28, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers* (U.S. Patent No. 6,438,584).
- Claims 9, 10, 17, 36, 44, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*, further in view of *Shima* (U.S. Patent No. 6,369,909).

II. Claim Rejections under 35 U.S.C. § 102(e)

Claims 1-5, 7, 11-13, 18-23, 25-27, 29-35, 37-42, and 46 are rejected under 35 U.S.C. § 102(e) as being anticipated over *Adamske*.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. *See* M.P.E.P. § 2131.

Claim 1 recites a method for controlling production and display of an image and "dynamically generating a printable version of said image...said printable version including said predetermined graphic symbol referencing said particular symbol set" and "if said destination service contains said particular symbol set and if said destination service is instructed to produce said printable version of said represented image, then forwarding said printable version of said represented image to said destination service." *Adamske* does not teach at least these limitations. *Adamske* teaches network-based document delivery that appears to provide a "collaborative signature function." *See* col. 9, lines 3-19. Neither the

destination printer 40 nor the remote print spooler server 30 of *Adamske* are taught as containing a particular symbol set or being checked for a particular symbol set. Accordingly, *Adamske* does not appear to teach at least these limitations of claim 1. Because *Adamske* does not teach all limitations of claim 1, claim 1 is not anticipated by the cited reference.

Claim 25 recites the limitation of “at least one destination computer accessible from said first computer and operable to access said composition, said destination computer representing a production device, such that, if said at least one said destination computer contains said particular symbol set, then said production device represented by said at least one said destination computer is operable to produce said represented image including printing said predetermined graphic symbol under interactive control of said first computer.” As shown above, neither the destination printer 40 nor the remote print spooler server 30 of *Adamske* are taught as containing a particular symbol set or being checked for a particular symbol set. According, *Adamske* does not appear to teach at least the above-recited limitation of claim 25. Because *Adamske* does not teach all limitations of claim 25, claim 25 is not anticipated by the cited reference.

Amended claim 38 recites the limitation of “if said destination service contains said particular symbol set, then interactively directing said destination service exclusively to access and produce said printable version of said represented image, including said predetermined graphic symbol.” As shown above, neither the destination printer 40 nor the remote print spooler server 30 of *Adamske* are taught as containing a particular symbol set or being checked for a particular symbol set. According, *Adamske* does not appear to teach at least the limitation of claim 38 recited above. Because *Adamske* does not teach all limitations of claim 38, claim 38 is not anticipated by the cited reference.

Claims 2-5, 7, 11-13, 18-23, 26-27, 29-35, 37, 39-42, and 46 depend from claims 1, 25, or 38. As such, they comprise all limitations of the base claim from which they depend. As shown above, *Adamske* does not teach all limitations of each of claims 1, 25, and 38. Accordingly, *Adamske* does not teach all limitations of claims 2-5, 7, 11-13, 18-23, 26-27, 29-35, 37, 39-42, and 46. Thus, Applicant respectfully requests that the rejection of record be withdrawn as *Adamske* does not anticipate claims 2-5, 7, 11-13, 18-23, 26-27, 29-35, 37, 39-42, and 46.

III. Claim Rejections under 35 U.S.C. § 103(a)

A. Overview

Claims 6, 8, 14-16, 24, 28, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*. Claims 9, 10, 17, 36, 44, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*, further in view of *Shima*. Applicant respectfully requests that, for the reasons herein, the rejections of record under 35 U.S.C. § 103(a) be withdrawn and these claims passed to allowance.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references do not meet the first or third criteria.

B. No Motivation

The Examiner states on page 11 of the Office Action that it would have been obvious “to modify *Adamske* with *Powers* in order to provides [sic] routing and delivery of electronic communications (*Powers*, col. 5, lines 59-63).” It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness. *See* M.P.E.P. § 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Here, the Examiner has not demonstrated that such a combination is desirable. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

On page 13 of the Office Action, the Examiner states that it would have been obvious “to combine the teachings of *Adamske-Powers* in order to provide an environment capable of

receiving and printing a composite document containing a plurality of resources of various file formats (Shima, col. 3, lines 18-22).” Applicant presumes that this statement applies to the rejection of claims 9, 10, 17, 36, 44, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*, further in view of *Shima*. Applicant respectfully asserts that the Examiner has not met the burden imposed by M.P.E.P. § 2143.01 and *In re Mills* as stated above, as the Examiner has not demonstrated that such a combination is desirable. Thus, the motivation for combining the references provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

C. Not All Limitations

Claims 6, 8, 14-16, 24, 28, and 43

Claims 6, 8, 14-16, 24, 28, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*. Each of claims 6, 8, 14-16, 24, 28, and 43 depends from claims 1, 25, and 38. As shown above under heading “Claim Rejections under 35 U.S.C. § 102(e),” *Adamske* does not teach or suggest all limitations of claims 1, 25, and 38. Accordingly, *Adamske* does not teach or suggest all limitations of claims 6, 8, 14-16, 24, 28, and 43. *Powers* does not cure the deficiencies of *Adamske* with respect to the claim limitations. Accordingly, not all limitations of claims 6, 8, 14-16, 24, 28, and 43 are taught or suggested by *Adamske* further in view of *Powers*, and these claims are not obvious over the cited combination of references.

Claims 9, 10, 17, 36, 44, and 45

Claims 9, 10, 17, 36, 44, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Adamske* further in view of *Powers*, further in view of *Shima*. Each of claims 9, 10, 17, 36, 44, and 45 depends from claims 1, 25, and 38. As shown above under heading “Claim Rejections under 35 U.S.C. § 102(e),” *Adamske* does not teach or suggest all limitations of claims 1, 25, and 38. Accordingly, *Adamske* does not teach or suggest all limitations of claims 9, 10, 17, 36, 44, and 45. Neither *Powers* nor *Shima* cure the deficiencies of *Adamske* with respect to the claim limitations. Accordingly, not all

limitations of claims 9, 10, 17, 36, 44, and 45 are taught or suggested by *Adamske* further in view of *Powers*, further in view of *Shima*, and these claims are not obvious over the cited combination of references.

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10007682-1, from which the undersigned is authorized to draw.

Dated: April 13, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482707955US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: April 13, 2005

Signature: 

Jay H. Perigo

Respectfully submitted,

By 

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

(214) 855-8186